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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-9889

EXAMINER

VANDERPUYE, KENNETH N

ART UNIT	PAPER NUMBER
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2661

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DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/544,141

Applicant(s)

KARVES ET AL.

Examiner

Kenneth N Vanderpuye

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-28,30-38,40-63,65 and 67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-28,30-32 and 40-63 is/are allowed.
- 6) ☒ Claim(s) 3,4,33,37,38,65 and 67 is/are rejected.
- 7) ☒ Claim(s) 3,5-16,40-53,65 and 67 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 33, 37-38, ~~66~~<sup>65</sup>, 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt(6,018,668) in view of Rhodes(6,343,120) and Molne(5,689,547) and Enzmann et al(6,516,203).

With regards to claims 3, Schmidt teaches a method comprising: for incoming calls identifying phone number of a caller at said wireless terminal(col. 2 lines 6-11). Schmidt fails to teach instructing the system to search said phonebook database to identify name of caller' and sending results of search to said wireless terminal such that if the caller identity search is successful, identification, identification is presented at said wireless terminal (Rhodes, Fig. 1, name database, col. 1 lines 40-58). Although Rhodes teaches a similar concept in a wired environment it would have been obvious to one of ordinary skill in the art to include a name with caller ID for the purpose of identifying the caller by name. The motivation

being that one does not always remember the numbers of potential callers, hence a name might be a better identifier. Rhodes teaches that when the identity search is not successful, the caller phone number is only presented at said wireless terminal. (col. 1 lines 59-67 to col. 2 lines 1-3, unknown is the same as presenting only the phone number). Both Schmidt and Rhodes are silent as to outgoing calls made from said wireless terminal. Molne teaches instructing the system to search said phonebook(Fig. 3@22c) database to locate at least one of a phone number(Molne considers only a telephone number but meets this limitation since applicant is claiming "one of") and destination of outgoing call; and sending results to said wireless terminal such that if the number of the call to be made is found in the database, the same is presented at said wireless(col. 2 lines 40-57). It would have been obvious to one of ordinary skill in the art to combine Molne with Schmidt and Rhodes for the purpose of using the name database for outgoing calls as well. The motivation being have a telephone directory functions. Molne is silent as to a situation when a phone number is not found in an initial query of the database, the terminal user optionally, may modify the search...or terminal identification process. This variation is obvious because unlisted numbers cannot be found in a name database,

hence the search process would have to be terminated. The decision to terminate or modify the search is obvious as a matter of design choice.

Molne, Schmidt and Rhodes fail to teach a WAP application. This is taught by Enzmann(Fig. 1). It would have been obvious to combine this feature with Molne, Schmidt and Rhodes for the purpose of wireless accessing a name database on the internet. The motivation being to enable calls over the internet.

With regards to claims 4, it is well known in the art that for a terminal to be able to access a database, uninterrupted accessibility and required as well as the protocol necessary to achieve this connection. It would have been obvious. Fig. 3 in Molne may be considered a WLAN.

Claim 33 is rejected for the same reasons as claim 3 because the journal database is functionally equivalent to the name database in Rhodes. Also it is well known in the art that for a terminal to be able to access a database, uninterrupted accessibility and required as well as the protocol necessary to achieve this connection. It would have been obvious. Fig. 3 in Molne may be considered a WLAN.

Claims 37-38 is rejected for the same reasons as claim 3 because the journal database is functionally equivalent to the name database in

Rhodes, and Molne, Schmidt and Rhodes fail to teach a WAP application. This is taught by Enzmann(Fig. 1). It would have been obvious to combine this feature with Molne, Schmidt and Rhodes for the purpose of wireless accessing a name database on the internet. The motivation being to enable calls over the internet.

Claims <sup>65 67</sup>~~64, 66~~ are rejected for the same reasons as claims 3-4.

***Allowable Subject Matter***

Claims 5-28, 30-32, 34-37, 40-63 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth N Vanderpuye whose telephone number is 703-308-7828. The examiner can normally be reached on M-F(7:30-5:00) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on 703-305-4703. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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Art Unit: 2661

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**KENNETH VANDERPUYE**  
**PRIMARY EXAMINER**

KNV  
July 25, 2004